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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/725,034	11/29/2000	Naoyuki Matsumoto	35.C14952	8951
5514	7590	01/26/2005	EXAMINER	
FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			SAIN, GAUTAM	
			ART UNIT	PAPER NUMBER
			2176	

DATE MAILED: 01/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/725,034

**Applicant(s)**

MATSUMOTO, NAOYUKI

**Examiner**

Gautam Sain

**Art Unit**

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**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 13 August 2004.  
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-40 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 103***

1) The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**1-1) Claims 1, 7, 8, 10, 11, 17, 18, 20, 21, 27, 28, 30, 31, 37, 38, 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brewster (US 2002/0018241, filed Jun 7, 1999 CIP), in view of "Web Hosting Services" by Lynchburg.net (hereinafter "Lynchburg") (published 1997, Non Patent Literature).**

**Claim 1, 11, 21, 31, Brewster teaches**

*period controlling means for storing information of a document control*

*period of the electronic documents rezistered by said rezisterinz means (ie., delivery schedule for the electronic document)(paragraph 20);*

*keeping means for keeoinz the electronic documents in the storage for a*

*predetermined period even aûer the document contr-o-t period of the electronic*

*document has expired (ie., regulating storage of at least one category of electronic mail or published document while user suspends service)(paragraph 25);*

*access prohibiting means for prohibiting an access from the external*

*apoaratus ' to the electronic document whose docllment control period has*

*expired (ie., suspending delivery of document based on schedule)(para 20),*

*period updating means for updating the said document control period for an*

*extension of the document control period based on a user confirmation (ie., delivery is suspended until reestablishment of delivery by a request by a user ... user can restart)(paragraph 20);*

*temporary access allowing means for allowing temporary access to the electronic document whose document control period has expired based on a predetermined charge (ie., user can adjust electronic document suspension, thereafter can access the document, thereafter suspension can resume); and*  
*transferring means for transferring the electronic document to the external apparatus based on a user request (ie., user can have the publications sent where they desire)(para 31, 26, 19).*

*wherein the transferred electronic document is a document whose document control period has not expired. a document whose document control period has been extended by said period updating means. or a document to which temporary access has been allowed by said temporary access allowing means (ie., electronic document delivery based on schedule of the latest publication)(para 20-22) and*

Brewster does not teach, but Lynchburg teaches

*registering means for registering electronic documents to a storage. the electronic documents being transmitted from an external transmitting apparatus (ie., storing users' web documents on Lynchburg servers)(page 1);*

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Brewster to include storing users web documents on Lynchburg servers, as taught by Lynchburg, providing the benefit storing web documents on the web server for

access by user's own device via internet (Lynchburg, page 1, top paragraph) on a document server (Brewster, Title and Abstract section).

**Claims 7, 17, 27, 37,** Brewster teaches

*wherein said keepinz means keeos ' ' ' an electronic doclzment*

*that is mest frequently accessed from the external aooaratlzs ' for a predetermined*

*' period and in a fixed voltme. and wherein said temporarv access allowinz*

*means allo-w-s the temporary access to the stored electronic document bwsed on ;*

*predetermined charge ' ' different from a regular charge fpz accessinz the document*

(ie., user can set up delivery schedule, which can be temporarily suspended. Where user access over Internet using a PDA, documents from document server. The subscription process was well known in the art to be a fee/free arranged service for licensed temporary access to information (ie., newspaper, magazines, publications, web hosting, ...)(para 20).

**Claims 8, 18, 28, 38,** Brewster teaches

*wherein said document searching means notifies the external aooaratus of the*

*information of document control period of the searched electronic document (ie., from*

users computer or PDA, user can notify the document server of the delivery schedule which is on the Internet)(para 20).

**Claim 10, 20, 30, 40,** Brewster teaches

*when update or deletion of the eaid electronic docllment is instructed from the external apparatus ' , said docnment ' ' Drocessinz means*

*determines whether or not to accept the update or the deletion of the sēd electronic*

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*document based on access authority information set in advance (ie., when delivery is suspended from user latest publications arrive from Internet but if the delivery is suspended, user does not receive the updating of the publication)(para 20).*

**1-2) Claims 2, 4, 12, 14, 22, 24, 32, 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brewster (as cited above), in view of "Lynchburg", further in view of Holt et al (US 5761497, issued Jun 1998).**

**Claim 2, 12, 22, 32, Brewster teaches**

*document processing ' ' means for ' ' updating and/.g.l: deleting the said electronic document stored in the storage (ie., replacing the stored publication so the latest publication is stored)(para 24); and*

Brewster does not expressly teach, but Holt teaches

*document searching means for searching ' electronic documents stored in the storage (ie , searching documents in the database)(col 1, lines 64-67).*

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Brewster to include searching documents in the database as taught by Holt, providing the benefit of a document retrieval system on a network with a document storage where user can search search the retrieved documents (Holt, Abstract).

**Claim 4, 14, 24, 34, Brewster teaches**

*wherein the sald' electronic document comprises:*

*control information of an electronic document including sid the*

*information of the document control period (ie., delivery schedule for document)(para 20);*

*attached information of an electronic document including summary  
information of a document (ie., brief summary of the news)(para 9) and/or; and  
a body of an electronic document transmitted from the external transmitting  
apparatus (ie., document server sends documents to users' devices over a network,  
Internet)(para 17, 19), and*

Brewster does not teach, but Holt teaches

*index information (ie., index for the document)(col 2, line 23)*

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Brewster to include a document index as taught by Holt, providing the benefit of a document retrieval system on a network with a document storage where user can search the retrieved documents (Holt, Abstract).

**1-3) Claims 3, 13, 23, 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brewster (as cited above), in view of "Lynchburg", further in view of Nguyen (US 6032150, filed Aug 1997).**

**Claims 3, 13, 23, 33, Brewster in view of Lynchburg does not teach, but Nguyen teaches**

*The document control apparatus according to  
claim 1, wherein said period controlling means ' stores the information of the  
document control period ' ' together with a body of the said electronic document  
embedded in the said electronic document (ie., program applet that is in the document  
contacts the server for control permission to display)(col 1, lines 55-67; fig 1, items 121,  
124).*

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Brewster in view of Lynchburg to include program applets in the document that contacts the server for control permission to display as taught by Nguyen, providing the benefit of a web document distribution system allowing restricted access for distribution (Nguyen, Abstract).

**1-4) Claims 5, 15, 25, 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brewster (as cited above), in view of "Lynchburg", further in view of Holt et al (US 5761497, issued Jun 1998), further in view of Leighton et al (US 6108703, filed May 1999).**

**Claim 5, 15, 25, 35, Brewster in view of Lynchburg and Holt do not teach, but Leighton teaches**

*wherein the electronic document stored in the storage comprises link information instead of the body of the electronic document the link information indicatinz a location of the body of the electronic document (ie., HTML documents allow for links to other files)(col 1, lines 20-25).*

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Brewster in view of Lynchburg and Holt to include HTML document that allow for links to other files as taught by Leighton, providing the benefit of a global document hosting system (Abstract, Title).

**1-5) Claims 9, 19, 29, 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brewster (as cited above), in view of "Lynchburg", further in view of Dharap (US 6256633, filed Jun 1998).**



**Claim 9, 19, 29, 39**, Brewster does not expressly teach, but Lynchburg teaches *user information storinR ' means for stprinR information of registered users (ie., web hosting service allows users to create their own presence on the web)(page 1); charge information storinz ' means for storinz ' charge information (ie., monthly charge)(page 1); and*

Brewster in view of Lynchburg does not teach, but Dharap teaches *history information storinM ' means for storinz information of ' electronic document access histories (ie., access history of user for electronic document)(summary section).* It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Brewster to include monthly charge as taught by Lynchburg, providing the benefit of storing web documents on the web server for access by user's own device via internet (Lynchburg, page 1, top paragraph) on a document server (Brewster, Title and Abstract section), further to include access history of user for electronic documents as taught by Dharap, providing the benefit of an electronic database with a user-profile driven information retrieval (Abstract section), where Brewster's setup of a delivery schedule for a subscription is a user-profile service (para 20).

### ***Response to Arguments***

Applicant's arguments with respect to claims 1-40 have been considered but are moot in view of the new ground(s) of rejection. A new search and consideration was necessary in light of the significantly amended limitations, including introducing the Brewster reference to teach the limitations as amended.

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gautam Sain whose telephone number is 571-272-4096. The examiner can normally be reached on M-F 9-5 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Feild can be reached on 571-272-4090. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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GS



**SANJIV SHAH**  
**PRIMARY EXAMINER**